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09/731,629	12/07/2000	Steven M. French	AUS920000812US1	1076
7590 Frank C. Nicholas CARDINAL LAW GROUP Suite 2000 1603 Orrington Avenue Evanston, IL 60201			EXAMINER NGUYEN, THANH T	
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**Technology Center 2100**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/731,629  
Filing Date: December 07, 2000  
Appellant(s): FRENCH ET AL.

\_\_\_\_\_  
Frank C. Nicholas  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 19, 2007 appealing from the Office action mailed September 26, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beelitz et al., (hereinafter Beelitz) U.S. Patent No. 6,182,275 in view of Cohn et al., (hereinafter Cohn) U.S. Patent No. 6,411,684.

3. As to claim 1, Beelitz teaches the invention as claimed, including a method of generating a list of target devices to be configured in communication with a server, comprising: creating a first list of target devices to be configured (col.7, lines 35-40, lines 48-51); identifying at least one addressed target device having an associated network address (Fig.1, Target computer system 137 associated with network connection 110, and col.15, lines 55-60); modifying the first list of target devices using the addressed target device (col.16, lines 4-10); and generating a modified list of target devices to be configured (col.18, lines 5-10), wherein the target devices are to be remotely booted by server (col.14, line 65 to col.15, line 7). But Beelitz does not explicitly teach persistently and concurrently in communication with the server by means of a network. However, Cohn teaches persistent and concurrent in communication with the server by means of a network (see col.10, lines 33-50, and col.34, lines 15-28). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to

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implement the teachings of Cohn into the computer system of Beelitz to have persistent and concurrent in communication with the server by means of a network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network.

4. As to claim 2, Beelitz teaches the invention as claimed, wherein the addressed target device is listed in at least one information source (col.7, lines 35-40).

5. As to claim 3, Beelitz teaches the invention as claimed, further comprising: adding the associated network address of the addressed target device to the first list of target devices (col.3, lines 5-15).

6. As to claim 4, Beelitz teaches the invention as claimed, further comprising: adding the addressed target device having an associated network address to the first list of target devices (col.17, lines 20-30).

7. As to claim 5, Beelitz teaches the invention as claimed, further comprising: removing the addressed target device having an associated network address from the first list of target devices (col.4, lines 59-64).

8. As to claim 6, Beelitz teaches the invention as claimed, further comprising: pre-configuring at least one pre configured target device (col.18, lines 60-67, and lines 5-10).

9. As to claim 7, Beelitz teaches the invention as claimed, further comprising: adding the pre configured target device to the first list (col.18, lines 60-67).

10. As to claim 8, Beelitz teaches the invention as claimed, further comprising: determining if a target device has an associated network address; and removing the target device from the modified list of target devices if it does not have an associated network address (col.7, lines 35-40).

11. As to claim 9, Beelitz teaches the invention as claimed, further comprising: configuring the target devices on the modified list (col.7, lines 4-56).

12. As to claim 11, Beelitz teaches the invention as claimed, further comprising: examining log data to determine if a target device has an associated network address (Fig.1 Target computer and associated network 110).

13. As to claim 12, Beelitz teaches the invention as claimed, further comprising: providing the modified list to the server (col.1, lines 40-55).

14. As to claim 13, Beelitz teaches the invention as claimed, including a computer program product in a computer usable medium for generating a list of target devices to be configured in communication with a server, comprising: means for creating a first list of target

devices to be configured (col.17, lines 35-40, and lines 48-50); means for identifying with an identification at least one addressed target device having an associated network address (col.15, lines 55-60); means for modifying the first list of target devices using the addressed target device (col.16, lines 4-10); and means for generating a modified list of target devices to be configured (col.18, lines 5-10) wherein the target devices are to be remotely booted by server (col.14, line 65 to col.15, line 7). But Beelitz does not explicitly teach persistently and concurrently in communication with the server by means of a network. However, Cohn teaches persistent and concurrent in communication with the server by means of a network (see col.10, lines 33-50, and col.34, lines 15-28). ). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Cohn into the computer system of Beelitz to have persistent and concurrent in communication with the server by means of a network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network.

15. As to claim 14, Beelitz teaches the invention as claimed, further comprising: means for storing the identification of the addressed target device (Fig.1, Target computer system 137).

16. As to claim 15, Beelitz teaches the invention as claimed, further comprising: means for adding the associated network address of the addressed target device to the first list of target devices (col.3, lines 5-15).

17. As to claim 16, Beelitz teaches the invention as claimed, further comprising: means

for adding the addressed target device having an associated network address to the first list of target devices (col.3, lines 5-15).

18. As to claim 17, Beelitz teaches the invention as claimed, further comprising: means for removing the addressed target device having an associated network address from the first list of target devices (col.7, lines 35-40).

19. As to claim 18, Beelitz teaches the invention as claimed, further comprising: means for pre configuring at least one target device listed in the first list (col.7, lines 45-50).

20. As to claim 19, Beelitz teaches the invention as claimed, further comprising: means for removing a target device without an associated network address from the modified list of target devices (col.8, lines 40-45).

21. As to claim 20, Beelitz teaches the invention as claimed, further comprising: means for configuring the target devices listed in the modified list.

22. As to claim 21, Beelitz teaches the invention as claimed, further comprising: means for examining packet data to determine if a target device has an associated network address (Fig.1 associated network 110).

23. As to claim 22, Beelitz teaches the invention as claimed, further comprising: means



for examining log data to determine if a target device has an associated network address (Fig.1 target computer system 137 associated with network 110).

24. As to claim 23, Beelitz teaches the invention as claimed, including a data processing system, the system including target devices and a server, wherein the target devices are persistently and concurrently in communication with the server by means of a network, comprising: means for creating a first list of target devices to be configured (see col.7, lines 35-40, lines 48-50); means for identifying at least one addressed target device having an associated network address (see col.15, lines 55-60); means for comparing the addressed target device to the target devices on the first list (see col.10, lines 10-52, col.16, lines 4-10); and means for generating a modified list of target devices to be configured based on the addressed target device (see col.18, lines 5-10, and col.14, line 65 to col.15, line 7). But Beelitz does not explicitly teach persistently and concurrently in communication with the server by means of a network. However, Cohn teaches persistent and concurrent in communication with the server by means of a network (see col.10, lines 33-50, and col.34, lines 15-28). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Cohn into the computer system of Beelitz to have persistent and concurrent in communication with the server by means of a network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network.

25. As to claim 24, Beelitz teaches the invention as claimed, further comprising: means

for storing information about the addressed target device (see col.7, lines 35-40).

26. As to claim 25, Beelitz teaches the invention as claimed, further comprising: means for configuring at least one target device (see col.18, lines 5-10).

27. As to claim 26, Beelitz teaches the invention as claimed, further comprising: means for determining if a target device has an associated network address (Fig.1 associated network 110).

28. As to claim 27, Beelitz teaches the invention as claimed, further comprising: creating a router list of target devices (see col.7, lines 35-40, lines 48-50); comparing the router list and the first list of target devices, and wherein modifying the first list of target devices using the addressed target device comprises modifying the first list of target devices based on the comparison (see col.10, lines 10-52, col.16, lines 4-10).

#### **(10) Response to Argument**

- Appellant argues that Beelitz does not teach or suggest “*The target device are persistently and concurrently in communication with the server by means of a network*” and instead cites to Cohn for such teachings.

Examiner respectfully disagrees. The applicant argument is vague. Beelitz discloses application claimed invention in claim 1, except limitation “*The target device are persistently and concurrently in communication with the server by*

*means of a network*" in claim 1. Therefore Cohn discloses "*The target device are persistently and concurrently in communication with the server by means of a network*" as shown in col.10, lines 33-50, and col.34, lines 15-28 (*due to the constant communication between the hubs, and using a real time communication protocol to input orders*).

- In response to applicant's argument that "*There is no reasonable expectation of success*", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).
- Appellant argues that "*The mere ability to combine references is insufficient to support a rejection*"

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, because it would have been provided specific functions that can operating or

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occurring at the same time and continuing without change in function or structure in the network.

**(11) Related Proceeding(s) Appendix**


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Thanh Tammy Nguyen

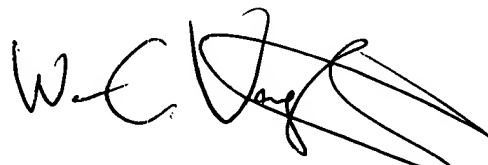
Examiner

  
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Conferees:

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DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

  
WILLIAM VAUGHN  
SUPERVISORY PATENT EX  
TECHNOLOGY CENTER 2100